

## **REMARKS/ARGUMENTS**

Applicants thank the Examiner for the careful consideration given the present application, and respectfully request favorable reconsideration of the application in view of the comments set forth below.

### ***Claim Objections***

Claim 1 has been amended to correct the typographical error “utilize” to the verb tense read “utilized” as suggested in the Office action.

### ***Claim Rejections – 35 U.S.C. §112, ¶2***

Claims 36-40 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for lack of sufficient antecedent basis. Claim 36 has been amended to provide “the print job media selection parameters” with sufficient antecedent basis as required by 35 U.S.C. §112, ¶2.

### ***Claim Rejections – 35 U.S.C. § 101***

Claims 1-16, 23-28 and 30-48 stand rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter.

With regard to claims 1, 10 and 41, the Office action explains that the claimed process includes a transformation, but that the claimed transformation is simply a “field-of-use” limitation. However, Applicants respectfully submit that the transformation test is but one of the two tests established by the Federal Circuit in the recent *In re Bilski* decision to identify patent-eligible subject matter. Under the so-called “machine-or-transformation” test, a claimed process is patent-eligible under §101 if: (1) it is tied to a particular machine or apparatus, **or** (2) it transforms a particular article into a different state or thing. *In re Bilski*, 545 F.3d 943, 954 (Fed. Cir. 2008) (citing *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972) (emphasis added)).

In the present application, the claimed process, as amended, is tied to a particular machine and also performs a suitable transformation to satisfy both tests of patent-eligible subject matter in compliance with 35 U.S.C. §101. For example, the processes in claims 1, 10

and 41 configure a multi-media printer that includes a print engine processor and a print subsystem for printing on a plurality of different media. Further, the receiving step recited in these claims is performed using the multi-media processor. Accordingly, Applicant respectfully submits that the processes of claims 1, 10 and 41 are tied to a particular machine under the machine-or-transformation test established in *Bilski*.

Additionally, Applicants respectfully submit that the processes of claims 1, 10 and 41, as amended, also perform a suitable transformation to satisfy the transformation prong to of the test to determine compliance with 35 U.S.C. §101. The *Bilski* decision at 962-963 cites *In re Abele*, 684 F.2d 902, 908-909 (CCPA 1982), recognizing that the transformation of electronic data is sufficient to satisfy the machine-or-transformation test if the electronic data transformed represents physical and tangible objects. In *Abele*, the electronically-manipulated data that was transformed to render the claim patent eligible was electronic X-ray data. In reviewing the claims in *Abele* under the machine-or-transformation test, the CAFC held that X-ray data “clearly represented physical and tangible objects, namely the structure of bones, organs, and other body tissues. Thus, the transformation of that raw data into a particular visual depiction of a physical object on a display was sufficient to render that more narrowly-claimed process patent eligible.” *Bilski* at 962-963. The CAFC also noted “for clarity that the electronic transformation of the data itself into a visual depiction in *Abele* was sufficient; the claim was not required to involve any transformation of the underlying physical object that the data represented.” *Bilski* at 963.

As correctly noted in the Office action, claims 1, 10 and 41 involve the transformation of electronic data which represent actual print media used in the multi-media printer. Similar to the manipulation of x-ray data in *Abele*, the transformation of the media selection parameters in claims 1, 10 and 41 constitute a transformation of a particular article under the machine-or-transformation test to satisfy 35 U.S.C. §101.

Accordingly, Applicants respectfully submit that processes of amended claims 1, 10 and 41 are both tied to a particular machine and transform a particular article and, as such, are directed to statutory subject matter under 35 U.S.C. §101.

Claims 23, 27, 30 and 36 also stand rejected under 35 U.S.C. §101 as encompassing both statutory and non-statutory embodiments. Regarding claims 30 and 36, Applicants respectfully

submit that both claims are product claims, and include structural features that prevent those claims from being directed solely to non-statutory subject matter. For example, claim 30 includes a configuration memory, in addition to the added print engine processor and print subsystem. The claimed multi-media printer of claim 30 is a product claim that can not reasonably be interpreted to encompass a carrier wave or other non-statutory subject matter. Similarly, claim 36 includes structural features such as a plurality of computing devices, a plurality of medical imaging devices and a multi-media printer, for example. Applicants respectfully submit that the invention of claim 36 can not reasonably be interpreted to cover non-statutory subject matter such as a carrier wave.

Regarding claims 23 and 27, Applicant has amended these claims to recite that the machine-readable storage medium is non-volatile. As amended, claims 23 and 27 are not directed to non-statutory subject matter.

For at least the above reasons, Applicants respectfully submit that claims 1-16, 23-28 and 30-48 are all directed to statutory subject matter in compliance with 35 U.S.C. §101.

#### ***Claim Rejections – 35 U.S.C. § 102(a)***

Claims 1-5, 8, 9, 10 and 23-27 stand rejected under 35 U.S.C. §102(a) as being anticipated by U.S. Patent No. 6,559,971 to Watts *et al.* (hereinafter “Watts”). However, Applicants respectfully submit that Watts fails to teach every claimed feature as required to maintain a rejection of the above claims under 35 U.S.C. §102(a).

Regarding claims 1 and 23, Applicants respectfully submit that Watts fails to teach receiving, with a multi-media printer, a print operation transmitted from a print client device comprising a first media selection parameter to be utilized for selecting a first medium to be used for the print operation. The print operation received by the printer in Watts is expressly described as lacking a media selection parameter. In Watts, the media selection parameter is intentionally omitted from the print operation, and a default media selection parameter is inserted into the print operation only after the print operation has been received by the printer. For example, Watts explains that “the particular PostScript command that generally accompanies a print job to specify a specific media size is expressly omitted from the control data 210.” Watts,

col. 6, lines 16-19 (emphasis added). Watts goes on to explain that “the PostScript file is customized 210 to not specify a media size. This allows a preferred or default media size 75 stored in the printer 10 to be utilized.” Watts, col. 7, lines 15-17 (emphasis added). In other words, if the media size is specified in the print operation received by the printer in Watts, the printer is not allowed to use the default media size so no media selection parameter is received by the printer in Watts as claimed in claims 1 and 23.

The Office action acknowledges that the media size is not specified in Watts, but explains that this suggests that the original media size stored in control 210 is ignored. However, Watts does not teach whether the demonstration page is ever saved with a specific media size that is later ignored. It appears that the demonstration page in Watts is originally saved with the media size unspecified to be printed on different printers, each supplied with a different size medium. And the fact that a certain result or characteristic *may* occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (emphasis added). As amended, claims 1 and 23 require the media selection parameter for selecting a first medium to be received by the printer, and overridden by the printer, which is absent from Watts.

Additionally, Watts also fails to teach that the printer receives a media selection parameter for selecting a first medium to be used for the print operation. The demonstration page in Watts is to be scaled by the printer to be printed over the entire surface of the medium available to that printer. If letter size paper is available to the printer in Watts, the demonstration page is scaled therein to fit letter size. If A4 paper is available to the printer in Watts, the demonstration page is scaled for A4 paper. The demonstration page is scaled in Watts to fit the medium available to the printer. The medium is not selected by the printer in Watts based on a media selection parameter as claimed.

For at least the reasons stated above, Applicants respectfully submit that Watts fails to teach or disclose every feature recited in claims 1 and 23 as required to maintain a rejection of those claims under 35 U.S.C. §102(a).

Regarding claims 10 and 27, Applicants respectfully submit that Watts fails to teach, using a multi-media printer, receiving media selection parameters defining a first media type and a first media size on which the content is to be printed for reasons analogous to those set forth

above. As explained above, Watts fails to teach that the printer receives a media selection parameter. Watts also fails to teach a printer receiving media selection parameters defining a first media type and a first media size on which the content is to be printed. Watts fails to teach a printer for printing on more than one medium type, and expressly teaches not transmitting a media size to a printer in contrast to claims 10 and 27.

Further with regard to claims 10 and 27, Applicants respectfully submit that Watts also fails to teach utilizing a default media selection parameter for the print operation if one of the media selection parameters included in the print operation is not operational. Watts does not teach that the printer receives a media selection parameter with the printer operation, or whether a media selection parameter is operational or not operational. The Office action explains that whether a media selection parameter in Watts is “operational” depends on whether the original size of the demonstration page matches the size of the medium on which the demonstration page is to be printed. However, according to Watts, an original size of the demonstration page is not transmitted to the printer. According to Watts, “the particular PostScript command that generally accompanies a print job to specify a specific media size is expressly omitted from the control data 210.” Watts, col. 6, lines 16-19 (emphasis added). Similarly, “the PostScript file is customized 210 to not specify a media size. This allows a preferred or default media size 75 stored in the printer 10 to be utilized.” Watts, col. 7, lines 15-17 (emphasis added). Accordingly, Watts fails to teach a printer receiving a media selection parameter that is not operational, or using a default media selection parameter when such a received media selection parameter is not operational as claimed.

For at least the reasons stated above, Applicants respectfully submit that Watts fails to teach or disclose every feature recited in claims 10 and 27 as required to maintain a rejection of those claims under 35 U.S.C. §102(a).

#### ***Claim Rejections – 35 U.S.C. § 103(a)***

Claims 30 and 32-35 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,450,571 to Rosekrans (hereinafter “Rosekrans”) in view of U.S. Patent No. 6,618,563 to Oakeson *et al.* (hereinafter “Oakeson”). However, Applicants respectfully submit

that the combination of Rosekrans and Oakeson fails to teach every claimed feature as required to maintain a rejection of the above claims under 35 U.S.C. §103(a).

Regarding claim 30, the combination of Rosekrans and Oakeson fails to teach, suggest or otherwise render predictable a printer including a parameter determination module to determine final print job media selection parameters for the print job based on an operational state of at least one of the decoded print job media selection parameters and the decoded print job data. As claimed, the printer determines whether one or more of the received media selection parameters is operational. The printer can utilize a default media selection parameter stored by the printer instead of, or in addition to the received media selection parameter to perform the print operation in the event that one of the received media selection parameters is not operational.

In contrast, Rosekrans utilizes a filter at the server to allow a user to manually select only operational media before the print operation is transmitted to the printer, thereby preventing a media selection parameter that is not operational from reaching the printer. For example, the Office action cites the operations performed by components of the server 25 in Figures 1, 2 and 6 of Rosekrans, in addition to the user interface 16, the UI mask 55. But the server in Rosekrans is not a printer as claimed, and lacks the claimed print engine processor and print subsystem. In Rosekrans, media selection parameters that are not operational are excluded from the choices that can be manually selected by the user for inclusion in the print job that is to eventually be transmitted to the printer. But if a media selection parameter could be selected and transmitted to the printer in Rosekrans, which Applicants maintain does not occur, the printer therein is not configured to utilize default values as claimed.

Further with regard to claim 30, one of ordinary skill in the art would not find it obvious to provide a printer with the claimed parameter determination module in view of the combined teachings of Rosekrans and Oakeson. The parameter determination module provided to the claimed printer determines final media selection parameters based on an operational state of a received parameter. The parameter determination module determines the final print job media selection parameters utilizing the received parameters and the default parameters. But if the printer does not receive parameters that are not operational as taught by Rosekrans, there is no need for the claimed parameter determination module to evaluate the operational state of such parameters.

For at least the above reasons, Applicants respectfully submit that the combination of Rosekrans and Oakeson fails to teach, suggest or otherwise render predictable every feature recited in claim 30 as required to maintain a rejection of that claim under 35 U.S.C. §103(a).

Claim 36 and 38-40 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Rosekrans in view of U.S. Patent No. 6,912,061 to Ozaki (hereinafter “Ozaki”) and further in view of Oakeson. However, Applicants respectfully submit that the combination of Rosekrans, Ozaki and Oakeson fails to teach every claimed feature as required to maintain a rejection of the above claims under 35 U.S.C. §103(a).

Claim 36 requires, among other features, a parameter determination module to receive decoded print job parameters and to determine final print job media selection parameters for the print job based on an operational state of at least one of the decoded print job media selection parameters and the decoded print job data. Applicants respectfully submit that such a feature is absent from the combined teachings of Rosekrans, Ozaki and Oakeson for reasons analogous to those discussed above with regard to claim 30. Further, Applicants also respectfully submit that Rosekrans, Ozaki and Oakeson also fail to teach, suggest or otherwise render predictable that the parameter determination module determines the final print job media selection parameters by utilizing at least one of the default media selection parameters in place of a decoded print job media selection parameter received by the printer. And similar to the discussion above for claim 30, one of ordinary skill would not find it obvious to include the claimed parameter determination module in view of the teachings of Rosekrans that prevent a not-operational parameter from being transmitted to the printer. For at least the above reasons, Applicants respectfully submit that the combination of Rosekrans, Ozaki and Oakeson fails to teach, suggest or otherwise render predictable every feature recited in claim 36 as required to maintain a rejection of that claim under 35 U.S.C. §103(a).

Claim 41 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Watts in view of Oakeson. However, Applicants respectfully submit that the combination of Rosekrans and Oakeson fails to teach every claimed feature as required to maintain a rejection of that claim under 35 U.S.C. §103(a).

For reasons analogous to those above for claims 1 and 23, the combination of Watts and Oakeson fails to teach, suggest or otherwise render predictable receiving a print operation at the

multi-media printer identifying a first medium on which the printer operation is to be performed and selecting a different medium for the print operation if one or more of the parameters identifying the first medium is not operational. As discussed above, the demonstration page received by the printer in Watts intentionally excludes the medium size so that the default medium size can be used by the printer. Watts does not describe overriding a media selection parameter based on the operational state of the medium identified by that media selection parameter as claimed in claim 41. For at least this reason Applicants respectfully submit that the combination of Watts and Oakeson fails to teach, suggest or otherwise render predictable every feature recited in claim 41 as required to maintain a rejection of that claim under 35 U.S.C. §103(a).

The remaining claims in the present application are allowable for the limitations therein and for the limitations of the claims from which they depend.

In light of the foregoing, it is respectfully submitted that the present application is in condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in condition for allowance, the Examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. CODO-45506.

Respectfully submitted,  
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